

REMARKS

Status of the Claims

Claims 4-13 were pending.

Claim 4-13 were subject to restriction.

Claims 4, 6, 8 and 12 are canceled.

Claims 5, 7, 9, 10, and 13 are amended.

Reconsideration and examination are respectfully requested.

Response to Restriction

The Office Action states that previously-pending claims 4-13 recited nine patentably distinct inventions falling in Groups I-IX and requires that applicant elect one of these Groups for prosecution.

In response to the restriction requirement, applicant elects, with traverse, the methods of treating cancer upon administration of compounds falling in previously-pending claims 8 or 12, i.e., the invention of Group I. Applicant traverses this restriction requirement and asks that the Examiner consider the scope of presently-pending Claim 5 as defining the Group I invention.

In response to the restriction, the following claim amendments have been made.

Claims 1-4 are canceled. Claim 5 is amended to incorporate formulae shown in previous Claim 8, with some modification, and to recite the claimed method pertains to treatment of cancer, as per the restriction requirement. Claim 8 is canceled as these formulae are substantially included in claim 5. Rather than recite the exact same four formulae of Claim 8, amended claim 5 recites two formulae, with the variable "Y" group included which can be one, two or three carbon atoms. The examples in the specification support Y being other than one or two carbon atoms (see, e.g., Examples 1, 2, etc), and the examples also

support the "Y" carbon atoms as being substituted or forming additional rings (see, e.g., Examples 17, 18, 19, etc.)

There are many common features shared by the methods of amended Claim 5 such that a search and examination of these methods would not be unduly burdensome.

In this vein, MPEP § 803.01 states that:

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

Applicant thus traverses the restriction requirement and requests that a search and examination in this case be performed with regard to all claims now pending.

With regard to the remaining claim amendments, claim 6 is canceled as the formula of claim 6 is beyond the restriction requirement. Claims 7 and 9 are amended so that these claims have proper antecedent basis given the amendments to claim 5 and cancellation of claim 6. Claim 10 was amended to incorporate the formula of claim 5, and to recite that the methods pertain to treatment of cancer pursuant to the restriction requirement. Claim 12 was canceled as the formulae of claim 12 were substantially included in claim 10, and claim 13 was amended for antecedent basis purposes.

Applicant reserves the right to pursue in a divisional application all subject matter omitted from the scope of the pending claims and/or subject matter that is otherwise recited in the specification and not claimed herein.

FEES

No claims have been added. Thus, it is believed no fee is due. However, in the event it is determined a fee is due, please charge same to Deposit Account No. 19-3880 in the name of Bristol-Myers Squibb.

SUMMARY

It is believed that the instant claims are in condition for allowance. The Examiner is invited to contact the undersigned if it is believed a telephonic communication would expedite the prosecution of this application.

Respectfully submitted,



Anastasia P. Winslow
Attorney for Applicant
Reg. No. 40,875

Bristol-Myers Squibb Company
Patent Department
P.O. Box 4000
Princeton, NJ 08543-4000
609-252-6996

Dated: August 2, 2004